UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,833	11/16/2001	Hiroshi Koga	862.C2437	7585

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EXAMINER
LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/987,833	KOGA, HIROSHI
	Examiner	Art Unit	
	Benjamin E. Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 November 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _1/11/02, 4/22/05_

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Claim Objections

1.   Claim 27 is objected to because of the following informalities: The claim contains a

spelling error that needs corrected. Specifically line 7 "pint process" is assumed to be print

process. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.   Claim 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

4.   Claim 23 recites the limitation "a comparison result of the information" in line 9, which

renders the claim indefinite because it is unclear to which information the limitation is referring.

Claim Rejections - 35 USC § 101

5.   Claim 16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-

statutory subject matter. The claim is drawn to a printer driver which is non-statutory subject

matter because it is a software object. The claim is a means plus function claim where the means

are not defined by the claims. The specification describes pure software embodiments of the

invention, see page 65, which is non-statutory subject matter. Amendments to the claims

specifically reciting hardware or, hardware and software are suggested.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1, 2, 4, 7-9, 11, 13, 15, 22-27, 29 are rejected under 35 U.S.C. 102(e) as being

anticipated by Ota, U.S. Patent No. 6,163,383. Referring to claims 1, 7, Ota discloses a method

for providing printing security wherein user's on a client system requests printing operations

(Col. 3, lines 19-22). A print server receives the print request and extracts the user information

and authenticates the user identity (Col. 3, lines 33-36 & Col. 7, lines 26-31), which meets the

limitation of extracting informaiton related to an application and/or a document for the print

process as attribute information, executing user authentication based on the attribute information.

Referring to claims 2, 8, Ota discloses that the user request includes an identification of a

specific printing operation (Col. 3, lines 19-21), which would meet the limitation of an

application name.

Referring to claims 4, 11, Ota discloses that the user request includes the user name (Col.

3, line 23), which meets the limitation of application user.

Referring to claims 9, 13, Ota discloses that the authentication system contains a client

computer, printer server, and printer (Figure 2), which meets the limitation of a client computer

or print server which is installed with a printer driver, a server for managing a network, and a

printer for executing the print process, which are connected via a network. The job receiving unit

of the printer server extracts the user informaiton for authentication (Col. 7, lines 30-31), which

meets the limitation of extraction means is included in the printer driver. The printer server also

contains a user verification unit (Figure 2), which meets the limitation of user authentication

means is included in the server.

Referring to claim 15, Ota discloses a method for providing printing security wherein

user's on a client system requests printing operations (Col. 3, lines 19-22). A print server

receives the print request and extracts the user information and authenticates the user identity

(Col. 3, lines 33-36 & Col. 7, lines 26-31), which meets the limitation of means of receiving

information related to an application and/or a document for the print process as attribute

information, means for extracting information required for user authentication from the attribute

information. In high-level authentication mode, the printer server sends the request and user

information to an authentication server for authentication and then notifies the printer server of

the result (Col. 3, lines 50-56), which meets the limitation of means of sending a user

authentication request appended with the extracted information to a server via a network. If

authenticated the user's print request is completed by the printer (Col. 3, lines 35-38), which

meets the limitation of means of, when user authentication has succeeded, controlling a printer to

execute the print process.

Referring to claims 16, 25, Ota discloses a method for providing printing security

wherein user's on a client system requests printing operations (Col. 3, lines 19-22). A print

server receives the print request and extracts the user information and authenticates the user

identity (Col. 3, lines 33-36 & Col. 7, lines 26-31), which meets the limitation of means of

receiving information related to an application and/or a document for the print process as

attribute information, means for extracting information required for user authentication from the

attribute information. The user request includes an identification of a specific printing operation (Col. 3, lines 19-21) and if authenticated the user's print request is completed by the printer (Col. 3, lines 35-38), which meets the limitation of means of sending print information appended with the extracted information to a printer.

Referring to claim 17, Ota discloses a method for providing printing security wherein user's on a client system requests printing operations (Col. 3, lines 19-22). A print server receives the print request and extracts the user information and authenticates the user identity (Col. 3, lines 33-36 & Col. 7, lines 26-31), which meets the limitation of means of receiving information, which is required for user authentication and is extracted from attribute information related to an application and/or a document for the print process, from a printer driver via a network. The print server contains an authentication table (Figure 4) that contains pre-registered information about each user, including the operations for which they have access (Col. 8, line 56 – Col. 9, line 3 & Figures 3B, 4), which meets the limitation of checking a user authentication result by comparing the extracted information with user authentication information which is registered in advance. The results of the authentication process are returned to the client (Col. 10, lines 56-57), which meets the limitation of means of returning the user authentication result to the printer driver via the network.

Referring to claim 22, Ota discloses that the user request includes the user name (Col. 3, line 23), which meets the limitation of application user.

Referring to claims 23, 26, Ota discloses a method for providing printing security wherein user's on a client system requests printing operations (Col. 3, lines 19-22). A print server receives the print request and extracts the user information and authenticates the user

identity (Col. 3, lines 33-36 & Col. 7, lines 26-31), which meets the limitation of means of

receiving information, which is required for user authentication and is extracted from attribute

information related to an application and/or a document for the print process, from a printer

driver together with print information, means of inputting user authentication information. The

print server contains an authentication table (Figure 4) that contains pre-registered information

about each user, including the operations for which they have access (Col. 8, line 56 – Col. 9,

line 3 & Figures 3B, 4), which meets the limitation of means of executing user authentication on

the basis of a comparison result of the information required for user authentication and the input

information.

Referring to claim 24, Ota discloses a method for providing printing security wherein

user's on a client system requests printing operations (Col. 3, lines 19-22). A print server

receives the print request and extracts the user information and authenticates the user identity

(Col. 3, lines 33-36 & Col. 7, lines 26-31), which meets the limitation of receiving information

related to an application and/or a document for the print process as attribute information, means

for extracting information required for user authentication from the attribute information. In

high-level authentication mode, the printer server sends the request and user information to an

authentication server for authentication and then notifies the printer server of the result (Col. 3,

lines 50-56), which meets the limitation of means of sending a user authentication request

appended with the extracted information to a server via a network. If authenticated the user's

print request is completed by the printer (Col. 3, lines 35-38), which meets the limitation of

means of, when user authentication has succeeded, controlling a printer to execute the print

process.

Referring to claim 27, Ota discloses a method for providing printing security wherein

user's on a client system requests printing operations (Col. 3, lines 19-22). A print server

receives the print request and extracts the user information and authenticates the user identity

(Col. 3, lines 33-36 & Col. 7, lines 26-31), which meets the limitation of extracting means of

extracting information related to an application and/or a document for the print process as

attribute information. In high-level authentication mode, the printer server sends the request and

user information to an authentication server for authentication and then notifies the printer server

of the result (Col. 3, lines 50-56), which meets the limitation of means output means of

outputting the attribute information extracted by said extracting means to said external

information processing apparatus using the attribute information for a user authentication for the

print process.

Referring to claim 29, Ota discloses that the user request includes an identification of a

specific printing operation (Col. 3, lines 19-21), which would meet the limitation of an

application name.

8.   Claims 1-14, 16-23, 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by

Kadowaki, U.S. Patent No. 6,313,921. Referring to claims 1, 7, Kadowaki discloses a printing

system wherein a printer and a personalizing server are connected through a network (Col. 6,

lines 55-56). Client computers are also connected to the network for generating and sending print

jobs to the printer (Col. 6, lines 63-65). Once the print job is received, the personalization server

extracts personalizing information stored for each machine type and for each user and then sends

this information to the printer (Col. 13, lines 9-15), which meets the limitation of extracting

information related to an application and/or a document for the print process as attribute

information. The printer then checks the personalizing information to make sure that the user has

not exceeding their printing privileges (Col. 14, lines 31-38), which meets the limitation of

executing user authentication based on the attribute information.

Referring to claims 2, 8, Kadowaki discloses that the document name is included in the

print job request (Col. 10, lines 51-53).

Referring to claims 3, 5, 10, 12, Kadowaki discloses that the cost for the print job is

calculated for the user (Col. 10, lines 30-44), which meets the limitation of when user

authentication has succeeded and a print process is executed, an accounting process of

expendables associated with the document print process, and for the user of the application, for

each user or each department of a group to which the user belongs.

Referring to claims 4, 11, Kadowaki discloses that the print job requests contain a user ID

(Col. 13, line 10), which meets the limitation of an application user.

Referring to claims 6, 14, Kadowaki discloses that the user ID contains a password (Col.

3, line 10).

Referring to claims 9, 13, Kadowaki discloses a printing system wherein a printer and a

personalizing server are connected through a network (Col. 6, lines 55-56), which meets the

limitation of a print server which is installed with a printer driver and a printer for executing the

print process connected via a network. Client computers are also connected to the network for

generating and sending print jobs to the printer (Col. 6, lines 63-65), which meets the limitation

of a client computer connected via a network. Once the print job is received, the personalization

server extracts personalizing information stored for each machine type and for each user and then

sends this information to the printer (Col. 13, lines 9-15), which meets the limitation of

extraction means included in the printer driver. The personalizing server contains authentication

means for authentication the print job request (Col. 18, lines 38- 66).

Referring to claim 16, Kadowaki discloses a printing system wherein a printer and a

personalizing server are connected through a network (Col. 6, lines 55-56). Client computers are

also connected to the network for generating and sending print jobs to the printer (Col. 6, lines

63-65). Once the print job is received, the personalization server extracts personalizing

information stored for each machine type and for each user and then sends this information to the

printer (Col. 13, lines 9-15), which meets the limitation of means for receiving informaiton

related to an application and/or a document for the print process as attribute informaiton, means

of extracting information required for user authentication from the attribute information, means

of sending print information appended with the extracted information to a printer.

Referring to claim 17, Kadowaki discloses a printing system wherein a printer and a

personalizing server are connected through a network (Col. 6, lines 55-56). Client computers are

also connected to the network for generating and sending print jobs to the printer (Col. 6, lines

63-65). Once the print job is received, the personalization server extracts personalizing

information stored for each machine type and for each user and then sends this information to the

printer (Col. 13, lines 9-15), which meets the limitation of means of receiving information, which

is required for user authentication and is extracted from attribute information related to an

application and/or a document for the print process, from a printer driver via a network. The

printer then checks the personalizing information to make sure that the user has not exceeding

their printing privileges (Col. 14, lines 31-38), which meets the limitation of means of checking a

user authentication result by comparing the extracted information with user authentication

informaiton which is registered in advance. The printer returns a report to the user about the print

job (Col. 14, lines 19-38), which meets the limitation of means of returning the user

authentication result to the printer driver via the network.

Referring to claims 18, 19, Kadowaki discloses that the cost for the print job is calculated

for the user (Col. 10, lines 30-44), which meets the limitation of when user authentication has

succeeded and a print process is executed, an accounting process of expendables associated with

the document print process, and for the user of the application, for each user or each department

of a group to which the user belongs. The print job requests also contain a group ID (Col. 13,

lines 34), which would meet the limitation of department of the group to which the user belongs.

Referring to claim 20, Kadowaki discloses that the printer updates the stored information

about the user. For instance, the printer will update the amount of pages the user can print after

each print job (Col. 13, lines 41-55 & Col. 14, lines 31-38), which meets the limitation of means

of registering and holding various kinds of attribute information of departments, affiliations,

individuals, print accounting states, associated with clients, users, and groups who make a

document print process, means of updating use states of a printer used in a print process for

respective departments, affiliations, and individuals.

Referring to claims 21, 22, Kadowaki discloses that the personalizing server contains

authentication means for authentication the print job request, and that the user ID and password

are items that are authenticated (Col. 18, lines 38- 66), which meets the limitation of attribute

information contains various kinds of document attribute information including password and

said checking means comprises means of executing department authentication of a user or the

like by comparing a password registered in said server on the basis of various kinds of document

attribute information, said checking means comprises means of granting permission of use of the application on the basis of the application attribute information.

Referring to claim 23, Kadowaki discloses a printing system wherein a printer and a personalizing server are connected through a network (Col. 6, lines 55-56). Client computers are also connected to the network for generating and sending print jobs to the printer (Col. 6, lines 63-65). Once the print job is received, the personalization server extracts personalizing information stored for each machine type and for each user and then sends this information to the printer (Col. 13, lines 9-15), which meets the limitation of means of receiving information, which is required for user authentication and is extracted from attribute information related to an application and/or a document for the print process, from a printer driver together with print information, means of inputting user authentication information. The printer then checks the personalizing information to make sure that the user has not exceeding their printing privileges (Col. 14, lines 31-38). The printer returns a report to the user about the print job (Col. 14, lines 19-38), which meets the limitation of means of executing user authentication on the basis of a comparison result of the information required for user authentication and the input informaiton.

Referring to claim 25, Kadowaki discloses a printing system wherein a printer and a personalizing server are connected through a network (Col. 6, lines 55-56). Client computers are also connected to the network for generating and sending print jobs to the printer (Col. 6, lines 63-65). Once the print job is received, the personalization server extracts personalizing information stored for each machine type and for each user and then sends this information to the printer (Col. 13, lines 9-15), which meets the limitation of means of receiving information related to an application and/or a document for the print process as attribute information,

extracting information required for user authentication from the attribute information, sending

print information appended with the extracted information to a printer.

Referring to claim 26, Kadowaki discloses a printing system wherein a printer and a

personalizing server are connected through a network (Col. 6, lines 55-56). Client computers are

also connected to the network for generating and sending print jobs to the printer (Col. 6, lines

63-65). Once the print job is received, the personalization server extracts personalizing

information stored for each machine type and for each user and then sends this information to the

printer (Col. 13, lines 9-15), which meets the limitation of receiving information, which is

required for user authentication and is extracted from attribute information related to an

application and/or a document for the print process, from a printer driver together with print

information, inputting user authentication information. The printer then checks the personalizing

information to make sure that the user has not exceeding their printing privileges (Col. 14, lines

31-38). The printer returns a report to the user about the print job (Col. 14, lines 19-38), which

meets the limitation of executing user authentication on the basis of a comparison result of the

information required for user authentication and the input informaiton.

Referring to claim 27, Kadowaki discloses a printing system wherein a printer and a

personalizing server are connected through a network (Col. 6, lines 55-56). Client computers are

also connected to the network for generating and sending print jobs to the printer (Col. 6, lines

63-65). Once the print job is received, the personalization server extracts personalizing

information stored for each machine type and for each user and then sends this information to the

printer (Col. 13, lines 9-15), which meets the limitation of extracting means of extracting

information related to an application and/or a document for the print process as attribute

information, and output means of outputting the attribute information extracted by said

extracting means to said external informaiton processing apparatus using the attribute

information for a user authentication for the print process.

Referring to claim 28, Kadowaki discloses that the document name is included in the

print job request (Col. 10, lines 51-53).

Referring to claim 29, Kadowaki discloses that the print job request contains a function

name that indicates which function to use (Col. 13, lines 15-21 & Col. 14, lines 11-15), which

meets the limitation of an application name.

Referring to claims 30-32, Kadowaki discloses that once the print job is received, the

personalization server extracts personalizing information stored for each machine type and for

each user and then sends this information to the printer (Col. 13, lines 9-15) through the network

(Col. 7, lines 1-2 & Figure 1). At the printer the external interface, connected to a CPU, receive

the print job (Col. 7, lines 2-3 & Figure 1), which meets the limitation of extracting means

extracts the attribute informaiton by calling a printer driver module and API provided between

OS and the printer driver module and causing OS to operate a document in said apparatus, API is

provided in the printer driver module, extracting means calls said API in response to a print

instructor inputted from the application. The CPU includes an Operating System that performs

the processes in accordance with designations of the program codes (Col. 27, lines 47-52).

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805.

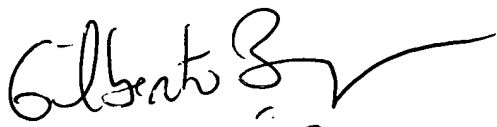The examiner can normally be reached on M-Th0 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin E. Lanier

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